

### **REMARKS**

Applicant appreciates the Examiner's thorough consideration provided in the present application. Claims 1-4, 8, 11-13, 16-18 and 23 are currently pending in the instant application. Claims 1-4, 8, 11-13 and 16-18 have been amended. Claims 1 and 23 are independent. Claim 23 has been added for the Examiner's consideration. Claim 22 has been cancelled. Reconsideration of the present application is earnestly solicited.

#### **Drawings**

Applicant appreciates the Examiner's acknowledgment of the receipt and the subsequent approval of the Drawing Change Approval Request filed on August 19, 2002.

#### **Double Patenting**

The Examiner has identified claim 22 as being a substantial duplicate of claim 1. This objection is respectfully traversed. Without conceding the propriety of the Examiner's characterization of claim 22, but merely to expedite the prosecution of the present application, Applicant has cancelled claim 22. Accordingly, this rejection has been obviated and/or rendered moot.

**Claim Rejections Under 35 U.S.C. § 103**

Claims 1, 3, 8, 11, 13, 16, 18 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubo et al. (U.S. Patent No. 5,828,461) in view of Nielsen et al. (U.S. Patent No. 5,845,122). Claims 2, 4, 12 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubo in view of Nielsen et al., and further in view of Nealon (U.S. Patent No. 5,023,635). These rejections are respectfully traversed.

In light of the foregoing amendments to the claims, Applicant submits that the prior art of record fails to teach or suggest each and every element of the unique combination of elements of the claimed invention. Further, Applicant submits that the alleged combination(s) of the prior art of record would not have been obvious to one of ordinary skill in the art. Accordingly, these rejections should be withdrawn.

With respect to claim 1, the prior art of record fails to teach or suggest the combination of elements of the claimed invention, including the limitation(s) of "means for instructing the special image processing to be carried out by said special image processing means, wherein *the special image processing is canceled if at least two special image processes* are instructed by said means for instructing and *said at least two special image processes are combined into a predetermined combination*, and *the special image processing is not canceled* if at least two special image processes are instructed by said means for instructing and *said at least two special image processes are*

*combined in a combination other than the predetermined combination, wherein the predetermined combination is a combination of at least two special image processes set in advance.*" (emphasis added)

In the claimed invention, it is possible to combine special image processings together, e.g., the operator can set any combination to be processed. However, the operator may also set any predetermined combination of processes as being incompatible for each user and may even combine three or more processes that may be processed with the claimed invention, e.g., as described on pages 23 to page 24 (line 9) of the present application. For example, it is possible to combine processes such as "Hypersharpness" with "Hypertone" and "Hypersharpness" with "Portrait Finish" in the claimed invention. Therefore, the combination of Hypersharpness with Hypertone and/or Hypertone with Portrait Finish may be selected and processed by a user. Alternatively, Hypersharpness may be cancelled when the combination of Hypersharpness with Portrait Finish is erroneously selected by a user.

However, the prior art of record fails to teach of suggest the ability to select combinations of special image processes. The Examiner appears to admit that Kubo et al. does not disclose instructing means for prohibiting unsuitable combinations of the image processes. In order to overcome this shortcoming, the Examiner has suggested that Nielsen et al. teach or suggest this feature. The Examiner has indicated that Nielsen et al. describe a radio button in FIG. 6 of the reference. However, the radio button may NOT be used

for the execution of more than one option. Instead, the Examiner asserts that it would be easy for one of ordinary skill in the art modify both the Kubo et al. and the Nielsen et al. references to achieve the claimed invention. Applicant submits that this interpretation appear unreasonable.

Applicant submits that even if the alleged combination were obvious, the alleged combination still fails to provide an image processing apparatus that permits the processing of combinations of special image processes. The claimed invention does prohibit the execution of certain processes, but these are all predetermined combinations of processes. By the Examiner's own admission, "Nielsen's tool prevents more than one option from being executed when a user selects multiple options." (Office Action, page 5, lines 1-4) Therefore, Applicant submits that the Examiner has not shown how the Nielsen tool, explicitly provided for the processing of one option at a time, may be applied to the Kubo et al. device to achieve the claimed invention, e.g., processing of multiple processes. Accordingly, this rejection should be withdrawn.

With respect to additional claim 23, the prior art of record fails to teach or suggest the combination of elements of the claimed invention, including the limitation(s) of "means for carrying out a special image processing on the image data read by the image reading device, the special image processing being specially designated by an operator request, *wherein said special image processing includes at least one of LF Lens Correction, Hypersharpness,*

*Hypertone, Facial Expression Improvement, RP Finish, Monotone Finish, Brightness Enhancement, Fine Finish, Portrait Finish, Red Eye Correction and Cross Filter processes;*” and “means for instructing the special image processing to be carried out by said special image processing means, *“wherein unsuitable combinations of image processings are prohibited from being executed on the image by said special image processing means and suitable combinations of image processings are permitted to be executed on the image by said special image processing means,”* said unsuitable combinations of image processings being at least a combination of image processings from said instructing means that is mutually opposite or erroneous. (emphasis added)

As alleged by the Examiner, the prior art of record fails to teach or suggest an image processing apparatus that permits selective processing of combinations of special image processes, e.g, prohibiting unsuitable combinations and/or permitting suitable combinations of special image processes. Accordingly, the rejections based upon Kubo et al. in view of Nielsen et al. should be withdrawn.

Applicant submits that the subject matter of additional claim 23 is fully supported by the original written description, including but not limited to, the special imaging processes generally described at pages 20 (Table 1), page 29 (lines 3-9), page 30 (lines 5-27) and page 31 (lines 1-21) of the present application; the necessary image processes described on page 18 of the present application; and original claims 1-4.

With respect to the Nealon reference, this reference has only been provided to show a system having a recording medium containing order information that is provided by a customer to means for instructing special image processing. Therefore, Applicant submits that this reference fails to address the shortcoming identified hereinabove and therefore does not cure the improper combination of Kubo et al. in view of Nielsen et al. advanced by the Examiner.

In accordance with the above discussion of the patents relied upon by the Examiner, Applicant respectfully submits that these documents, either in combination together or standing alone, fail to teach or suggest the invention as is set forth by the claims of the instant application.

Accordingly, reconsideration and withdrawal of the claim rejection are respectfully requested. Moreover, the Applicant respectfully submits that the instant application is in a condition for allowance.

As to the dependent claims, Applicant respectfully submits that these claims are allowable due to their dependence upon an allowable independent claim, as well as for additional limitations provided by these claims.

### **CONCLUSION**

Since the remaining patents cited by the Examiner have not been utilized to reject the claims, but rather to merely show the state-of-the-art, no further comments are necessary with respect thereto.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

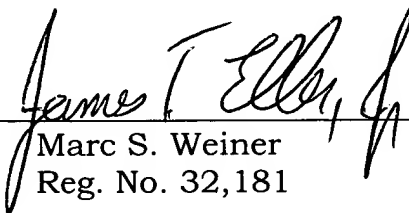
In the event there are any matters remaining in this application, the Examiner is invited to contact Matthew Shanley, Registration No. 47,074 at (703) 205-8000 in the Washington, D.C. area.


Applicant respectfully petitions under the provisions of 37 C.F.R. § 1.136(a) and § 1.17 for a one-month extension of time in which to respond to the Examiner's Office Action. The Extension of Time Fee in the amount of **\$110.00** is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #39,538  
Marc S. Weiner  
Reg. No. 32,181

  
MSW/MTS/cl

P. O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

Attachment: Version with Markings to Show Changes Made

**MARKED-UP VERSION OF AMENDMENTS**

**IN THE CLAIMS**

**Claim 22 has been cancelled.**

**Claim 23 has been added.**

**The claims have been amended as follows:**

1. (Twice Amended) An image processing apparatus for processing an image recorded on a recording medium, said image processing apparatus comprising:

an image reading device for reading the image recorded on the recording medium as digital image data, subjecting the read digital image data to predetermined image processing, and outputting processed image data;

means for carrying out a necessary image processing on all of the image data read by the image reading device;

means for carrying out a special image processing on the image data read by the image reading device, the special image processing being specially designated by an operator request; and

means for instructing the special image processing to be carried out by said special image processing means, wherein the special image processing is canceled if at least two special image processes are instructed by said means for instructing and said at least two special image processes are combined into a predetermined combination, and the special image processing is not canceled if at least two special image processes are instructed by said means for



instructing and said at least two special image processes are combined in a combination other than the predetermined combination, wherein the predetermined combination is a combination of at least two special image processes set in advance [wherein unsuitable combinations of image processings are prohibited from being executed on the image by said special image processing means, said unsuitable combinations of image processings being at least a combination of image processings from said instructing means that is mutually opposite or erroneous].

2. (Amended) [An] The image processing apparatus according to claim 1, wherein said instructing means gives an [instructions] instruction in accordance with the contents of a recording medium which is provided for a customer and at which the contents of an order are recorded.

3. (Amended) [An] The image processing apparatus according to claim 1, wherein the processing which is performed by said special image processing means is an image processing which includes at least an image structure effect for correcting the overall structure of the image, a color reproduction effect for correcting the color tone of the image, and a special effect for performing a variety of special processings for the structure[,] and the color tone in accordance with the image read by the image reading device.

4. (Amended) [An] The image processing apparatus according to claim 2, wherein the processing which is performed by said special image processing means is an image processing which includes at least an image structure effect for correcting the overall structure of the image, a color reproduction effect for correcting the color tone of the image, and a special effect for performing a variety of special processings for the structure[,] and the color tone in accordance with the image read by the image reading device.

8. (Twice Amended) An image processing apparatus according to claim 1, wherein a special image processing instructed last is given priority and a special image processing instructed first is cancelled when the [unsuitable] predetermined combination of special image processings has been instructed by said instructing means.

11. (Amended) [An] The image processing apparatus according to claim 1, further comprising [notifying] means for notifying an operator of the contents of the special image processings which have actually been instructed by said instructing means.

12. (Amended) [An] The image processing apparatus according to claim 2, further comprising [notifying] means for notifying an operator of the contents

of the special image processings which have actually been instructed by said instructing means.

13. (Amended) [An] The image processing apparatus according to claim 3, further comprising notifying means for notifying an operator of the contents of the special image processings which have actually been instructed by said instructing means.

16. (Amended) [An] The image processing apparatus according to claim 1, wherein said image reading device includes a monitor which can display an image based on read image data in a plurality of display states including a single frame display state and a plural frame display state, and an instruction issued from said instructing means is [made to be valid] only valid when the contents of the image processing of said special image processing means instructed by said instructing means[,] and the display state of the monitor do not match with [a] the predetermined combination.

17. (Amended) [An] The image processing apparatus according to claim 2, wherein said image reading device includes a monitor which can display an image based on read image data in a plurality of display states including a single frame display state and a plural frame display state, and an instruction issued from said instructing means is [made to be valid] only valid when the

contents of the image processing of said special image processing means instructed by said instructing means[,] and the display state of the monitor do not match with [a] the predetermined combination.

18. (Amended) [An] The image processing apparatus according to claim 3, wherein said image reading device includes a monitor which can display an image based on read image data in a plurality of display states including a single frame display state and a plural frame display state, and an instruction issued from said instructing means is [made to be valid] only valid when the contents of the image processing of said special image processing means instructed by said instructing means[,] and the display state of the monitor do not match with [a] the predetermined combination.